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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,300	02/21/2002	Holger Warth	Mo6879/LeA 33,977	8773
157	7590	12/10/2004	EXAMINER	
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,300

Applicant(s)

WARTH ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14,16-24 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14,16-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 11/5/2004. Applicants' amendments to claims 1, 14, 16 and 26, cancellation of claim 15, and new claims 28 and 29 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 1, 2, 4-14 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, last line, the phrase "diameter of less and 200 nm" is vague and indefinite, because it is unclear to the Examiner what is the exact scope the diameter. Clarification and correction is required.

Rejections Based on Prior Art

5. Claims 1, 2, 4-14, 16-18, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhr et al. (US 5272193) in view of Witman et al. (US 4603170), generally as set forth in sections 4 and 5 of Office action dated 8/12/2004, together with the following response to argument.

It is noted that newly amended independent claim 1 now incorporates the elements of cancelled claim 15, i.e., "wherein said composition further comprises at least one inorganic particulate material selected from the group consisting of talc, mica, wallastonite, quartz and titanium dioxide, said particulate material having an average particle diameter of less and 200 nm."

With respect to Applicants' argument "Fuhr et al does not disclose a polycarbonate composition that includes an inorganic particulate material ..." (Remarks, page 6, third paragraph from the bottom), the Examiner notes that while the amendment overcomes the prior 102(b) rejection in section 4 of Office action dated 8/12/2004, the Examiner repeats (see section 5 of Office action dated 8/12/2004) that Fuhr does teach that thermoplastic molding compounds optionally contains stabilizers, pigments, fillers, antistatic agents, metal compounds and flame protective agents (flameproofing agents), etc. (column 13, lines 3-6). Although Fuhr lacks express teachings of the compositions of the pigments and fillers, it is noted that Witman's invention is also directed to a thermoplastic polycarbonate molding compound (Abstract), and Witman expressly teaches that mica, silicates, quartz, talcum, titanium dioxide and wollastonite, etc., are preferred fillers which may also have a reinforcing action (column 6, lines 59-66). As such, it would have been obvious to one of ordinary skill in the art to modify Fuhr's molding compounds with Witman's fillers, motivated by the desire to obtain a reinforcing action. As to the average particle diameter of the fillers in amended claim 1 and newly added claims 28 and 19, in the absence of evidence to the contrary, it the Examiner's position that a suitable average particle diameter is either anticipated by Fuhr in view of Witman, or an obvious optimization to one of ordinary skill in the art of reinforcing

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particulate fillers, motivated by the desire to obtain a required reinforcing property. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

For newly amended claim 14, it is noted that the inorganic particles are deleted from the Markush group of the additives. However, the Examiner notes that Fuhr's express teaching of flame protective agents (flameproofing agents), as set forth above, still reads on the instant invention as claimed.

With respect to Applicants' argument "The thermoplastic molding compounds of Witman et al include as a necessary component, a polyester ... Fuhr et al ... provides no disclosure or suggestion as to the inclusion in their compositions of polyesters ... As such, a skilled artisan would not be motivated to combine or otherwise modify the disclosures of Fuhr et al and Witman et al." (Remarks, page 7, third paragraph), the Examiner repeats (see page 5 of Office action dated 8/12/2004) that since both Fuhr and Witman are directed to polycarbonate molding compounds, they are from the same field of endeavor, as such, it is proper to combine the teachings of pertinent fillers of Fuhr and Witman. Further, it should be noted whether Witman also teaches polyester as a component in the molding compound is irrelevant to the relied upon teachings of fillers. Finally, in response to Applicants' argument to the references individually, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.

6. Claims 19-22, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reihls et al. (US 6296908) in view of Fuhr et al. (US 5272193), and further in view of Witman et al. (US 4603170), generally as set forth in section 6 of Office action dated 8/12/2004, together with the following response to argument.

With respect to Applicants' argument "Fuhr ... discloses thermoplastic polycarbonate compositions that include, as an essential component an anti-dripping agent ... As is known to the skilled artisan, a polycarbonate layer containing anti-dripping agents ... as described by Fuhr et al would likely result in a laminate of polyurethane and polycarbonate layers having degraded appearance ... As such, a skilled artisan would not be motivated to combine or otherwise modify Reihls et al and Fuhr et al to arrive at Applicants' presently claimed composition" (Remarks, page 8, second paragraph), the Examiner notes that Applicants fail to provide any evidentiary support for the aforementioned argument, and it is well settled that Attorney arguments cannot take the place of evidence.

7. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reihls et al. (US 6296908) in view of Fuhr et al. (US 5272193), and further in view of Witman et al. (US 4603170) and JP 07-268207 (Abstract), generally as set forth in section 7 of Office action dated 8/12/2004, together with the response to argument as set forth above, and additional reasoning as follows.

With respect to Applicants' argument "Masuda's laminate contains, as an essential component, a metal perchlorate and/or perchloric acid modified hydrotalcite. Reihls et al does not disclose or suggest that the polyurethane layer of their composite material contain a metal perchlorate and/or perchloric acid modified hydrotalcite. As

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such, a skilled artisan would not be motivated to combine Reihs et al and Masuda together" (Remarks, page 9, last full paragraph), the Examiner repeats (see page 6 of Office action date 8/12/2004) that since both Reihs and JP '207 (Masuda) are directed to a polycarbonate laminate, they are from the same field of endeavor, as such, it is proper to combine the teachings of Reihs and JP '207. Further, it should be noted whether JP '207 also teaches a metal perchlorate and/or perchloric acid modified hydrotalcite is irrelevant to the relied upon teachings of a PVC/polyurethane laminate. Finally, in response to Applicants' argument to the references individually, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC
Victor S Chang
Examiner
Art Unit 1771

12/1/2004


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700